

REMARKS**Status of Claims:**

Claims 1-19 are pending in the application. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

Response to the Advisory Action of December 2, 2005:

The Examiner did not enter the Amendment filed September 21, 2005 arguing that the limitations as to the structure of the urethane had not been claimed. The present amendment specifically claims the urethane of Figure 1.

Disclosure Supporting the Instant Amendment:

Claims 1 and 13 are hereby amended to change the previously-added recitation "substantially the absence of exogenous photoinitiators" to "the absence of exogenous photoinitiators." Support for the recitation is present in the original disclosure in Example 1 (reciting "[n]o photoinitiators...were added.") (US200510119366, para. [0042]).

Rejections Under 35 U.S.C. § 112, 1st Paragraph:

Claims 1-24 were rejected under 35 U.S.C. § 112, 1st Paragraph, as containing subject matter which was not described in the specifications in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner objected that the recitation "the substantial absence of exogenous photoinitiators was not recited in the specification in relation to the invention.

The Applicants specifically do not admit that the objected to recitation was unsupported. However, Claims 1 and 13 are hereby amended to delete the recitation "substantial."

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Rejection Under 35 U.S.C. § 102(b), or in the Alternative, Under 35 U.S.C. § 103(a):

Claims 1 and 6-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, as obvious over Nerad (5,641,426).

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every recitation of the claimed invention.¹ In determining anticipation, no claim recitation may be ignored.² Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims.³ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102.⁴ The evidentiary record fails to teach the absence of photoinitiator.

Nerad teaches the use of thiol-ene systems that contain photoinitiator, such as NOA 65 and NOA 68 (col.6, lines 45-49) and systems that do not contain photoinitiator, such as RCC-15C (col. 8, line 38). However, in each case, the thiol-ene system is further blended with a photoinitiator (see each of Examples 1-23). In no case does Nerad teach the use of a thiol-ene chemistry in the absence of a photoinitiator.

Rejections Under 35 U.S.C. § 103(a):

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad in view of Hagstrom (5,578,693),

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.⁵ All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.⁶ (MPEP § 2143.03). When evaluating the scope of a claim, every recitation

¹ See MPEP § 706.02.

² See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

³ See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

⁴ See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

⁵ *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁶ *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

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in the claim must be considered. See e.g. *In re Ochiai*.⁷ (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention.

As discussed above, Nerad teaches the use of photoinitiator with thiol-ene chemistries. Hagstrom cannot supply the missing teaching, relating to the absence of photoinitiator because the Examiner cites Hagstrom as relating to the structure of the urethane monomer.

Conclusion:

In view of the above, consideration and allowance are respectfully solicited.

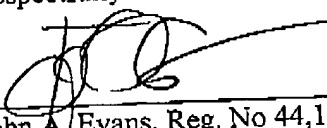
Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Date: January 23, 2006

Respectfully submitted,


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⁷ *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).